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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,622	07/30/2003	Mark Schmidt	108-194USANB0	9042

7590 09/30/2005
Thomas J. Perkowski, Esq., P.C.
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EXAMINER

KIM, AHSHIK

ART UNIT PAPER NUMBER

2876

DATE MAILED: 09/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/630,622	Applicant(s) SCHMIDT ET AL.	
	Examiner Ahshik Kim	Art Unit 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/30/03 (Initial filing & Prelim Amdt).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 93-100 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 93-100 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/3/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Preliminary Amendment

1. Receipt is acknowledged of the amendment filed on July 30, 2003. In the amendment
5 claims 1-92 are canceled, and claims 93-100 were newly added. Currently, claims 93-100
remain in the examination.

Specification

2. The lengthy specification and a large number of drawings have not been checked to the
10 extent necessary to determine the presence of all possible minor errors. Applicant's cooperation
is requested in correcting any errors of which applicant may become aware in the specification.

Claim Objections

3. Claim 93 is objected to because of the following informalities:
15 Re claim 93, line 10: substitute "." With ",", after "therewithin."
Appropriate correction is required.

Obviousness-Type Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in
20 public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise
extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple
assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759
F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA
1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163
25 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome
an actual or provisional rejection based on a nonstatutory double patenting ground provided the

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conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5

5. Claims 93-100 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 93-107 of US application 10/342,433 to Schmidt et al. (hereinafter "Schmidt").

Although the conflicting claims are not verbatim identical, it is the Examiner's view that they are virtually the same, and not patentably distinct from each other. Claim 93 of Schmidt reads "A wireless bar code symbol reading system for use in a work environment, said wireless bar code symbol reading system comprising:

(A) a wireless hand-supportable bar code symbol reader in two-way RF communication with a base station operably connected to a host system, by way of an RF-based wireless data communication link having a predetermined RIF communication range over which two-way communication of data packets can occur in a reliable manner, said wireless hand-supportable bar code symbol reader including

(1) a hand-supportable housing;

(2) a bar code symbol reading mechanism, disposed in said hand-supportable housing, for automatically reading a bar code symbol on an object and automatically producing a symbol character data string representative of said read bar code symbol;

(3) a first RF-based transceiver circuit, disposed in said hand-supportable housing, for transmitting to said base station, groups of data packets associated with said produced symbol character data string;

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(4) a data packet group buffer, disposed in said hand-supportable housing, for buffering one or more groups of data packets associated with said symbol character data string produced in response to the reading of a bar code symbol by said bar code symbol reading mechanism;

5 (5) a data transmission circuit, disposed in said hand-supportable housing, for transmitting said produced symbol character data string to either said first RF RF-based transceiver circuit or said data packet group buffer;

(6) a device controller, disposed within said hand-supportable housing, for controlling the operation of said wireless hand-supportable bar code symbol reader; and

10 (B) said base station installable within a work environment and including

(1) a base station housing,

(2) a second RF-based transceiver circuit, disposed within said base station housing, for receiving groups of data packets corresponding to the symbol character data string transmitted from said first RF-based transceiver circuit, and

15 (3) a base station controller mounted in said base station housing, for controlling the operation of said base station;

wherein said first and second RF-based transceiver circuits enable a RF-based wireless data communication link between said wireless hand-supportable bar code reader and said base station;

20 wherein said first and second RF-based transceiver circuits cooperate to enable the communication of data packets between said wireless hand-supportable bar code symbol reader and said base station, over said RF-based wireless data communication link;

wherein said second RF-based transceiver includes means for automatically generating and transmitting a reference signal to said first RF-based transceiver circuit over said RF-based wireless data communication link;

wherein said first RF-based transceiver circuit includes means for automatically receiving
5 said reference signal and detecting the strength of said reference signal; wherein said device controller is programmed to automatically detect when said wireless hand-supportable bar code symbol reader is located inside of said predetermined RF communication range based on measuring the strength of said detected reference signal, and thereupon to automatically transmit to said second RF-based transceiver, the symbol character data string produced
10 while said wireless hand-supportable bar code symbol reader is located inside of said predetermined RF communication range; and

wherein said device controller is programmed to automatically detect when said wireless hand-supportable bar code symbol reader is located outside of said predetermined RF communication range based on measuring the strength of said detected reference signal, and
15 thereupon to automatically collect and store in said data packet group buffer, the symbol character data string produced while said wireless hand-supportable bar code symbol reader is located outside of said predetermined RF communication range.”

Claim 93 of the instant application, in the Examiner’s view, essentially recites the same apparatus: a hand-supportable reader comprising a first RF-based transceiver; a base station
20 comprising a second RF-based transceiver; and the hand-supportable reader checks the strength of the reference signal from the base station. The only distinction between Schmidt and the instant application is as follows: Schmidt transmits the information stored in the buffer; and the

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instant application is deactivated to “sleep mode” to conserve electrical power. As disclosed in the cited reference below, a portable reader transiting to “sleep mode” is very well known in the art.

Infrared (IR) recited in claim 99 of the instant application is recited in claim 106 of

5 Schmidt.

To the extent that the instant claim is identical in scope and therefore generic to the patented claims [species], In re Goodman 29 USPQ 2d 2010 CAFC 1993, states that a generic claim cannot be issued without a terminal disclaimer, if a species claim has been previously been patented.

10

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

15 (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

20

7. Claims 93 and 99 are rejected under 35 U.S.C. 102(e) as being anticipated by Lanzaro et al. (US 6,811,088, hereinafter Lanzaro).

Lanzaro discloses a portable data collection device (see abstract) wirelessly

25 communicating with base station utilizing a radio frequency or Infrared (col. 3, lines 24+). The portable hand reader is a handheld type (col. 1, lines 65+). As shown in figure 1, Both hand-held

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device and base station (or the transmitting unit) must have a radio frequency transceiver (col. 6, lines 42+). The portable terminal turns itself to sleep mode to conserve power (col. 7, lines 20+).

Conclusion

5 I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Swintek (US 5,528,025); Keucken (US 5,581,707); Reynolds et al. (US 6,318,636) disclose portable scanners communicating with host in a wireless manner. Applicant is respectfully suggested to carefully review these references.

10 II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Ahshik Kim* whose telephone number is (571)272-2393. The examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru Friday.

15 If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (571)272-2398. The fax number directly to the Examiner is (571)273-2393. The fax phone number for this Group is (703)872-9306.

20 Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

25 *All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.*

30 Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished application is available for Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions or access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

35 Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

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A handwritten signature in black ink, appearing to read 'Ahshik Kim', with a stylized, cursive script.

Ahshik Kim

Primary Examiner

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September 27, 2005